



## UNITED STATES PATENT AND TRADEMARK OFFICE

**DOCKETED**
 UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
 Address: COMMISSIONER FOR PATENTS  
 P.O. Box 1450  
 Alexandria, Virginia 22313-1450  
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/632,373	08/03/2000	Moshe Voloshin	CISCP025C1	1949

7590

12/23/2003

Barton E Showalter Esq  
 Baker Botts LLP  
 Suite 600  
 2001 Ross Avenue  
 Dallas, TX 75201-2980

*Amendment Due:*  
*March 23, 2004*

EXAMINER

NGUYEN, PHUONGCHAU BA

ART UNIT PAPER NUMBER

2663

DATE MAILED: 12/23/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

RECEIVED	Boxet <input checked="" type="checkbox"/>	Wrapper <input checked="" type="checkbox"/>
DEC 11 2003	RVE Docketed	
NOTES DOCKET	Reference(s) <input checked="" type="checkbox"/>	

**Office Action Summary**

Application No.

09/632,373

Applicant(s)

VOLOSHIN, MOSHE

Examiner

Phuongchau Ba Nguyen

Art Unit

2865

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-848)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Application/Control Number: 09/632,373

Page 2

Art Unit: 2665

***Specification***

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 is vague and indefinite because it is not clear what is meant by "...the is not selected to activate the master clock circuit ..." (lines 4-5). Please clarify what was not being selected to activate the master clock circuit.

Claim 13 is vague and indefinite because it is not clear what is meant by "...wherein the means for indicating is responsive to the remote power state

Application/Control Number: 09/632,373

Page 3

Art Unit: 2665

signal and said means for indicating". Also, claim 13 is vague and Indefinite because it is not clear what is meant by "means for determining whether or not the repeater is configured in a stack of repeaters in manner indicating that the repeater is not selected to activate the clock master circuit". Please clarify how the repeater being configured so that it would not be selected to activate the clock master circuit.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being Incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are: there is no other repeater is powered on when the second repeater is powered on.

#### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple

Application/Control Number: 09/632,373

Page 4

Art Unit: 2665

assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 10-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4 of U.S. Patent No. 6,108,312. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application claims 10, 11 & 13 merely broaden the patented claim 1 by eliminating "stackable Fast Ethernet", "weak pull up voltage source" and "weak pull up voltage being derived from a switched power supplied in the fast Ethernet repeater so that" of the patented claim 1; also the application claims 11 & 13 merely broaden the patented claim 1 by rephrasing the patented claim 1 in the shorten version as application claim (i.e., eliminating wordy claims with variety of words "stackable

Application/Control Number: 09/632,373  
Art Unit: 2665

Page 5

Fast Ethernet", "weak pull up voltage source", "a first on pin logical state"; and rephrase the wordy phrase "a second stackable fast Ethernet repeater including a power state output pin, the power state output pin being configured to be connected to ground when the second fast Ethernet repeater is powered on" with application limitation ---a first repeater comprising means for indicating whether the first repeater is powered on---it is noticed that the second repeater in the patented claim is now renamed as the first repeater in application claim). Likewise, application claim 15 merely broaden patented claim 1 by rephrasing patented claim 1 using only the main functions of determining whether the first repeater is on or off... without wordy limitations, e.g., "stackable Fast Ethernet", "weak pull up voltage source", "a first on pin logical state"...etc.. Also, application claims 12 & 14 merely broaden the patented claims 4 & 7 by eliminating "stackable Fast Ethernet" and "weak pull up voltage source"(claims 4 & 7), and "the weak pull up voltage being derived from a switched power supply in the fast Ethernet repeater"(claim 4) of the patented claims 4 & 7. It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same

Application/Control Number: 09/632,373

Page 6

Art Unit: 2665

function as before. In re Karlson, 136 USPQ 184 (CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference's element whose function is not needed would be obvious to one skilled in the art.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuongchau Ba Nguyen whose telephone number is 703-305-0093. The examiner can normally be reached on Monday-Friday from 10:00 a.m. to 3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu can be reached on 703-308-6602. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.



STEVEN H. D. NGUYEN  
PRIMARY EXAMINER



Phuongchau Ba Nguyen  
Examiner